Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ARTHUR A. BRANSTROM, DONATA R. SIZEMORE, and JERALD C. SADOFF

Appeal No. 2001-1881
Application No. 08/711,961

ON BRIEF

Before WINTERS, ADAMS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is back before us after the Decision on Appeal mailed May 30, 2003 (May Decision on Appeal). In that decision, we affirmed the obviousness-type double patenting rejection of claims 45-55 over claims 1-17 of U.S. Patent No. 5,824,538, all of the pending claims. We also entered new grounds of rejection over claims 45-51, 53 and 54 under 37 CFR § 1.196(b).

Under 37 CFR § 1.196(b), if appellants choose to continue prosecution before the examiner, in order to preserve the right to review under 35 U.S.C.

§§ 141 or 145, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner.

In this case, appellants chose to continue prosecution before the examiner, and offered an amendment under 37 CFR § 1.196(b)(1), canceling claims 45-55, the subject of the May Decision on Appeal, and offered new claims 56-65.[1] See Paper No. 29. In response, the examiner indicated that claims 56, 57, 59-62 and 64-66[2] were entered, and that those claims overcame the grounds of rejection under 37 CFR § 1.196(b). See Paper No. 30.

The examiner then stated that the claims remain subject to the obviousness-type double patenting rejection affirmed in the May Decision on Appeal, and the case was returned to the Board.

Even though we now have new claims 56, 57, 59-62 and 64-65 before us, appellants do not dispute that the new claims are subject to the obviousness-type double patenting rejection affirmed in the May Decision on Appeal. Appellants' only remarks were that they would file a Terminal Disclaimer, which has not been filed at this time. See Paper No. 29. Under these facts, we summarily affirm the obviousness-type double patenting rejection as to newly entered claims 56, 57, 59-62 and 64-65.

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[1] Claims 58 and 63 were not entered as being drawn to subject matter not considered on appeal and not addressed by the new grounds of rejection set forth under 37 CFR § 1.196(b). See Paper No. 30.

[2] We assume that the reference to claim 66 is a typographical error, as appellants offered new claims 56-65, and thus the examiner in fact meant that claims 56, 57, 59-62 and 64-65 have been entered.

The period for seeking court review begins with the date of this decision. No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Sherman D. Winters)
Administrative Patent Judge)
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) BOARD OF PATENT
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